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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/519,913

12/30/2004

Katsumi Shinjo

3003

7590

07/31/2006

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EXAMINER

REESE, DAVID C

ART UNIT

PAPER NUMBER

3677

DATE MAILED: 07/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/519,913

Applicant(s)

SHINJO, KATSUMI

Examiner

David C. Reese

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

THIS FINAL ACTION IS RESPONSIVE TO THE AMENDMENT FILED 5/9/2006.

- Claim 7 is pending.

Claim Objections

[1] Claim(s) 7 were previously objected to because of informalities. Applicant has successfully addressed these issues in the amendment filed on 5/9/2006. Accordingly, the objection(s) to the claim(s) 7 have been withdrawn.

Claim Rejections - 35 USC § 103

[2] The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

[3] Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bjorklund et al., US-4,233,880, in view of case law.

Although the invention is not identically disclosed or described as set forth 35 U.S.C. 102, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a designer having ordinary skill in the art to which said subject matter pertains, the invention is not patentable.

As for Claim 7, Bjorklund et al. shows of a drill screw comprising:
a drill part (16);

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a tapping screw part (above 16) connected to the drill part (16);
a fastening screw part (14) connected to the tapping screw part (above 16); and
a screw head part (12) for conducting and providing a turning force, wherein the drill part (16) and the tapping screw part (above 16) are made of a high-carbon chrome series stainless steel (col. 1, lines 65-70);

the fastening screw part including the screw head part is made of a nickel series stainless steel (abstract);

the nickel series stainless steel of the fastening screw part (14) including the screw head part (14) is SUS-305J1 or SUS-316 (col. 1 lines 8-11) and consists of a stainless steel satisfying high corrosion-resistivity (col. 1, lines 57-59) and high tensile force guaranteeing ISO A-2-70 and A-4-70 after thread rolling.

The difference between the claim and Bjorklund et al. is that Bjorklund et al. does not explicitly state the exact specifications of the materials (SUS-420J2 or JIS-G4051, and SUS-305J1 or SUS-316; guaranteeing ISO A-2-70 and A-4-70) of which the above features (the drill part and the tapping screw part; fastening screw part including the screw head part, respectively) are composed. First and foremost, it is pertinent to point out that it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious engineering design choice. *In re Leshin*, 125 USPQ 416. It is also common knowledge to choose a material that has sufficient strength, durability, flexibility, hardness, etc. for the application and intended use of that material. Further, to show that said materials are known in the art and used specifically for their application and intended

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use of that material; additional documents have been provided to help show the prevalence of such materials in the art.

In addition to the 300 series stainless steel taught by Bjorklund et al, with respect to the fastening screw part including the screw head part, the claim states that such a feature can be composed of either SUS-305J1 or SUS-316. Both <http://www.azom.com/details.asp?ArticleID=863> and <http://www.assda.asn.au/aasp/index.asp?pgid=17970> teach of properties of SUS-316; properties of such that include corrosion resistance, heat resistance, and its excellent fabricability characteristics. It is also taught that typical applications for 316 include structural members, and hot water systems, etc. Thus, it would have been obvious for one skilled in art to use such a material for the fastening screw part including the screw head part for its corrosion resistance and heat resistance properties and applications thereof.

Secondly, with respect to the drill part and the tapping screw part, the claim states that such a feature can be composed of either SUS-420J2 or JIS-G4051. <http://www.shineintl.co.kr/product/stainlesssteel/sheetcoil.htm> as well as <http://www.e-pipe.co.kr/jpn/EJIS/pipe-text/struct/4051.html> teaches of SUS-420J2 stating how quenching such steel yields high hardness products. The hardness of which is used for machine structural use, precision assembly parts, and helping to improve the drilling characteristics of the drill part and tapping screw part.

Response to Arguments

[4] Applicant's arguments filed 5/9/2006 regarding rejections under 35 U.S.C. 103 have been fully considered but they are not persuasive. To begin, the examiner would like to point out that

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it is the claims that define the claimed invention, and it is claims, not specifications, that are anticipated or unpatentable. *Constant v. Advanced Micro-Devices Inc.*, 7 USPQ2d 1064. With regard to the same, when discussing an apparatus claim, the process by which the claimed structure is made is irrelevant so long as the final product as claimed is the same or obvious in view of the prior art and/or to that which is inherently known to those skilled in the art. In the instant case, though Bjorklund et al. may not teach of the exact same specifications of materials used in the process or final product of the instant invention; it is pertinent to point out that it is simply what the combination of references makes obvious to one of ordinary skill in the pertinent art. *In re Bozek*, 163 USPQ 545 (CCPA 1969). And as stated above in the instant rejection, it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious engineering design choice. *In re Leshin*, 125 USPQ 416. It is also common knowledge to choose a material that has sufficient strength, durability, flexibility, hardness, etc. for the application and intended use of that material. The different specifications for both the carbon and nickel as presented by Bjorklund et al. have been shown and described via multiple literature showing the applicability of using such specific contents and why one skilled in the art would readily appreciate the possible incorporation of said contents into a screw as provided by Bjorklund et al.

Applicant states that the applicant's invention is different from the development by Bjorklund et al. in purpose and fundamental constitution. In response, first, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed, its purpose, does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). With regard to

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possible differences in fundamental constitution, the pertinent question to ask after possible emulation of features is whether such differences, if any, are obvious to one skilled in the art. Bjorklund et al. teaches of the structural features of the screw including that of the carbon and nickel materials in their appropriate locations on said screw, but Bjorklund, however, does not teach of some of the exact specifications of said materials; specifications of which, in view of the prior art submitted regarding the benefits of using said specifications for said materials, make it apparent that such [specifications] are obvious to one skilled in the art.

Further, it is not required that the prior art disclose or suggest the properties newly-discovered by an applicant in order for there to be a prima facie case of obviousness. *See In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897, 1905 (Fed. Cir. 1990). Moreover, as long as some motivation or suggestion to combine the references is provided by the prior art taken as a whole, the law does not require that the references be combined for the reasons contemplated by the inventor. *See In re Beattie*, 974 F.2d 1309, 24 USPQ2d 1040 (Fed. Cir. 1992); *In re Kronig*, 539 F.2d 1300, 190 USPQ 425 (CCPA 1976) and *In re Wilder*, 429 F.2d 447, 166 USPQ 545 (CCPA 1970). The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. *In re Keller*, 642 F. 2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In this regard, a conclusion of obviousness may be based on common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference. *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969).

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Conclusion

[5] **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

[6] Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Reese whose telephone number is (571) 272-7082. The examiner can normally be reached on 7:30 am-6:00 pm Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J.J. Swann can be reached at (571) 272-7075. The fax number for the organization where this application or proceeding is assigned is the following: (571) 273-8300.

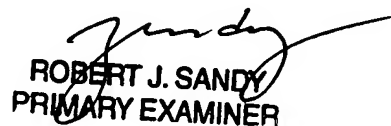
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DCR



7/20/06

David Reese
Assistant Examiner
Art Unit 3677



ROBERT J. SANDY
PRIMARY EXAMINER